

**REMARKS**

This communication responds to the Office Action mailed on November 3, 2005. No claims are amended, no claims are canceled, and no claims are added. As a result, claims 1-2, 4-5, 7-16, and 18-27 are now pending in this Application.

**§102 Rejection of the Claims**

Claims 13-14 were rejected under 35 USC § 102(e) as being anticipated by Obradovich et al. (U.S. 6,542,812, Provisional Application Serial No. 60/160,326 filed on October 19, 1999; hereinafter “Obradovich”). The Applicant does not admit that Obradovich is prior art and reserves the right to swear behind this reference at a later date. In addition, because Obradovich does not disclose the identical invention claimed, the Applicant respectfully traverses this rejection.

With respect to claim 13, the Office asserts that the mobile element of Obradovich includes a processor (103, fig. 1) that “acts as a comparator in as much as user can select required profile among many preset user profiles for downloading information from a server ... This means: When user selects a profile, processor (103, fig. 1) has to compare what user has selected with various user profiles so that user can obtain information from a server based on user selection corresponding to selected profile.” However, this assertion mischaracterizes the teachings of the reference.

A careful reading of Obradovich reveals that all comparisons with respect to profiles are not made by the processor 103, but rather by the user (as admitted in the Office Action at pg. 10), or the server 630. For example, Obradovich teaches that “upon receiving the request from ... [the hand-held element] *server 630 determines the user’s personal favorites as requested ...*”. Obradovich, Col. 8, lines 30-34. In addition, “... the personal favorites *selected by the server 630 may vary with the GPS data identifying the current location of [the hand-held element].*” *Id.* at Col. 8, line 66- Col. 9, line 1. Thus, Obradovich does not teach or suggest a mobile element including “a comparator module communicatively coupled to the memory to compare the first and second service preferences,” as claimed by the Applicant in claim 13. Instead, Obradovich

describes such comparisons as being conducted by the user, or a remote server. Claim 14, which includes all of the elements of claim 13, is not anticipated by Obradovich for the same reasons.

It is respectfully noted that anticipation under 35 USC § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. *See Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). In fact, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added).

Further, if the Office relies on inherency in alleging that “comparison is implicit in the processor in order to select required profile information corresponding to selected profile” then, as recited in MPEP § 2112, "... the examiner must provide basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art,” citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). No such basis has been provided. In fact, there is no technical reason why the server 630 of Obradovich needs any assistance whatsoever with respect to making comparisons of profile information – it is entirely possible for the server 630 to act on its own in this respect.

Therefore, since Obradovich does not teach all of the limitations of claims 13 and 14, as described above, what is disclosed by Obradovich is not identical to the subject matter of the embodiments claimed, and the rejection of claims 13-14 under § 102(e) is improper. Reconsideration and allowance are respectfully requested.

#### §103 Rejection of the Claims

Claims 1-2, 4-5, 7-12, 15-16, 20, 22, and 24-26 were rejected under 35 USC § 103(a) as being unpatentable over Obradovich in view of Rautila et al. (U.S. 6,549,625; hereinafter

“Rautila”). Claims 18-19, 23, and 27 were rejected under 35 USC § 103(a) as being unpatentable over Obradovich in view of Rautila, and further in view of Masaki (EP 0883270 A1; hereinafter “Masaki”). First, the Applicant does not admit that Obradovich, Rautila, or Masaki are prior art, and reserves the right to swear behind these references in the future. Second, since a *prima facie* case of obviousness has not been established in each case, the Applicant respectfully traverses these rejections.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988). In combining prior art references to construct a *prima facie* case, the Examiner must show some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art that would lead an individual to combine the relevant teaching of the references. *Id.* The M.P.E.P. contains explicit direction to the Examiner that agrees with the *In re Fine* court:

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d (BNA) 1443 (Fed. Cir. 1992). However, while it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 U.S.P.Q.2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 U.S.P.Q. 171, 174 (C.C.P.A. 1979)). However, the level of skill is not that of the person who is an innovator but rather that of the person who follows the conventional wisdom in the art. *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 474, 227

U.S.P.Q. 293, 298 (Fed. Cir. 1985). The requirement of a suggestion or motivation to combine references in a *prima facie* case of obviousness is emphasized in the Federal Circuit opinion, *In re Sang Su Lee*, 277 F.3d 1338; 61 U.S.P.Q.2D 1430 (Fed. Cir. 2002), which notes that the motivation must be supported by evidence in the record.

No proper *prima facie* case of obviousness has been established because: (1) combining the references does not teach all of the limitations set forth in the claims, (2) there is no motivation to combine the references, and (3) combining the references provides no reasonable expectation of success. Each of these points will be explained in detail, as follows.

***Combining References Does Not Teach All Limitations:*** First, with respect to independent claims 1, 13, 16, 20, and 25, no combination suggested in the Office Action will render all of the claim limitations. Obradovich does not disclose “a comparator module … to compare the first and second service preferences” as part of the mobile element (claims 1 and 13), or downloading an application “when the second service preference is determined by the mobile element to be related to a first service preference stored in the mobile element” (claim 16), or “upon the mobile element determining that the first service preference is related to the second service preference” (claims 20, 25) as claimed by the Applicant. Neither does Rautila or Masaki.

As noted above, Obradovich makes use of a server to match user preferences to broadcast services. Rautila relies on the user, rather than the mobile element, to determine which preferences will be selected. *See* Rautila, Col. 9, lines 34-43. Masaki does not match user preferences at all. Thus, independent claims 1, 13, 16, 20, and 25 are nonobvious. This conclusion applies with even greater force respecting dependent claims 2, 4-5, 7-12, 14-15, 18-19, 21-24, and 26-27 since any claim depending from a nonobvious independent claim is also nonobvious. *See* M.P.E.P. § 2143.03.

***No Motivation to Combine References:*** The Office asserts that it would be obvious to combine Obradovich with Rautila because “this arrangement would provide … application programs for the user to obtain information from servers …”. However, this assertion is incorrect. Obradovich operates by sending user location GPS data to the server in order to provide the user with a useful route map. *See* Obradovich, Col. 8, lines 30-45. Rautila teaches away from using such data, since “not all mobile terminals will have GPS functionality” and “the

position transceiver overcomes the location problem of the prior art by indicating and transmitting its own very exact predefined position.” Rautila, Col. 1, lines 39-47 and Col. 2, lines 24-27. Using the position position transceiver location of Rautila would not provide a useful route map to the user of Obradovich. Thus, there is no motivation to combine Obradovich with Rautila, as such would render the apparatus of Obradovich inoperative. The addition of Masaki does nothing to remedy this deficiency.

The test for obviousness under § 103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985). The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01.

Thus, it is respectfully noted that references must be considered in their entirety, including parts that teach away from the claims. See MPEP § 2141.02. Since Rautila teaches away from the claimed combination, there is no motivation to combine the references. Further, the use of unsupported assertions in the Office Action does not satisfy the explicit requirements needed to demonstrate motivation as set forth by the *In re Sang Su Lee* court. Therefore, the Examiner appears to be using personal knowledge, and is again respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2). To-date, no such affidavit has been provided.

**No Reasonable Expectation of Success:** Modifying Obradovich to implement the application download capability of Rautila will not provide a mobile element capable of determining the existence of related preferences. Neither will combining Obradovich and Masaki. Further, both combinations are at odds with determining the location of the mobile element, since Rautila disclaims this process, and one of ordinary skill in the art would not be led to make a combination which leads to an inoperative result.

Therefore, since there is no evidence in the record to support the disclosure by any combination of Obradovich, Rautila, or Masaki of a mobile element that determines related preferences, and can download applications based on the comparison, as claimed by the Applicant; since there is no motivation to supply the missing elements (because the references

teach away from such a combination); and since no reasonable expectation of success arises, a *prima facie* case of obviousness has not been established with respect to independent claims 1, 13, 16, and 20, and 25, or any of the claims that depend from them. It is therefore respectfully requested that the rejection of claims 1-2, 4-5, 7-12, 15-16, 18-20, and 22-27 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

*Allowed Claims*

While claim 21 is included among the list of “rejected” claims in the Office Action Summary form PTOL-326, it does not appear to have been addressed anywhere in the body of the Office Action. Thus, the inclusion of claim 21 in the PTOL-326 form listing seems to be the result of a typographical error, and claim 21 may be in fact allowed.

In view of the arguments set forth above, the Applicant believes that claim 21 is indeed in condition for allowance, and such is respectfully requested. However, if this is not the case, the Applicant respectfully requests that the Office set forth any concerns with respect to claim 21 in a subsequent, non-final action so the Applicant may be afforded a full and fair chance to address them.

**RESPONSE UNDER 37 C.F.R. 1.116 – EXPEDITED PROCEDURE**

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**Page 13**

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**CONCLUSION**

The Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant's attorney Mark Muller at 210-308-5677, or the undersigned (at 612-349-9592) to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 3rd day of January 2005.

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